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**OFFICE OF PETITIONS**

In re Application of

Vazquez

Application No. 09/459,182

Filed: 7 December, 1999

Attorney Docket No. (None)

CORRESPONDENCE

This is correspondence regarding a letter filed via FAX on 20 February, 2004, 2003, and treated as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition under 37 C.F.R. §1.181 is **GRANTED**.

**NOTE:**

The record suggests Petitioner's lack of familiarity with practice before the Office. Petitioner may wish to retain the services of a registered practitioner to assist Petitioner in his efforts.<sup>1</sup>

**BACKGROUND**

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to the Notice of Missing Parts mailed on 19 March, 2003, in connection with the previously filed Continued with a reply due (absent a request and fee for extension of time) on or before 19 May, 2003;

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<sup>1</sup> Petitioner may identify registered practitioners in her area by going to the Office website, [www.uspto.gov](http://www.uspto.gov), and clicking on the "Patents" button, then in the "Reference" column clicking on "Roster of Patent Attorneys and Agents." At the "Attorney/Agent" search, Petitioner can insert the name his community or a neighboring major community to identify local registered practitioners.

- as a result, the application was deemed abandoned after midnight 19 May, 2003;
- notably, a Motion to Withdraw as Counsel of Record (which contained a conflicting and incorrect address for the Applicant/Petitioner herein as 28001 Madrid (in central Spain) while the correct address for Applicant/Petitioner herein was 36310 Vigo Pontevedra (on the Atlantic coast of Spain)) was filed on 31 March, 2003, and granted on 5 May, 2003;
- Notice of Abandonment was mailed on 10 October, 2003;
- Petitioner filed the original petition *pro se* under 37 C.F.R. §1.137(a) stating and evidencing (with a formal doctor's certificate and translation) illness as the basis of his unavoidable delay, however, the certificate and translation do not address the time period of Petitioner's illness, and as a result, the petition was dismissed on 29 January, 2004;
- Petitioner's FAX inquiry addresses the fees issue, and a review of the papers filed herein indicate that the missing part—a filing fee for the CPA filed by Petitioner's prior Counsel—were authorized to be charged in Counsel's filing of 31 March, 2003, to Deposit Account 23-1925 (a condition confirmed in the communication of 27 February, 2004), however, the Office failed to act on that authorization.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on

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<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

petition.<sup>3</sup> Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup>

And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

#### As to the Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>8</sup>

The CPA filing fee and surcharge were, in fact, previously authorized in the 31 March, 2003, filing, and they now are charged to Deposit Account 23-1925.

#### CONCLUSION

Accordingly, Petitioner satisfied the burdens set forth in Delgar v. Schulyer, and the petition under 37 C.F.R. §1.181 hereby is **granted** and the 10 October, 2003, Notice of Abandonment is **vacated** and fees in connection with the petition are waived.

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<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>5</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and/or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and/or deposited for shipment.

<sup>8</sup> See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

The instant application is returned to Technology Center 3600 for processing of the CPA and further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon', with a stylized flourish at the end.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions